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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,269	07/15/2003	Sandeep Bhatt	02077(3600-395-01)	8766

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EXAMINER
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HENDRICKSON, STUART L

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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09/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/620,269	<b>Applicant(s)</b> BHATT, SANDEEP	
	<b>Examiner</b> Stuart Hendrickson	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/30/08.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21, 24 and 26-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 24 and 26-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following applies to all rejections herein:

The Industrial Carbon reference is presented as evidence that as-synthesized carbon blacks meet the 325 mesh limitation, except for the 'poor' grades. Note also the sulfur values reported as typical. The Medalia article has extended discussion and pictures indicating that carbon black has a small particle size and meets the 325 mesh limitation. The concluding section teaches 1% ash as conventional. Iodine and nitrogen are shown to correlate by the Dee Snell article pg. 186 submitted.

Claims 1-21, 24, 26-30, 34-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Sant 5877250, in view of Industrial Carbon and the Medalia article.

The reference teaches what appears to be the claimed carbon black. Specification pg. 13 indicates that the present carbon black is the same as that of Sant, with no modifications made.

Claims 1-21, 24, 26-30, 34-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Sant 5877251, in view of Industrial Carbon and the Medalia article.

The reference teaches what appears to be the claimed carbon black. Specification pg. 13 indicates that the present carbon black is the same as that of Sant, with no modifications made.

Claims 1-21, 26-30, 34-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-53 of U.S. Patent No. 6852790, in view of Industrial Carbon and the Medalia article. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim common, overlapping, subject matter in the ranges of values.

The '790 patent elucidates in col. 3 overlapping particle size, and other properties. The polymers are indicated in col. 8.

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Claims 1-10, 26, 29-33 and 41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6482386, in view of Industrial Carbon and the Medalia article. Although the conflicting claims are not identical, they are not patentably distinct from each other because the numerical values overlap. Column 4 teaches a tube shape and fluffy form, which indicates the 325 mesh limitation is met.

Claims 1-9, 11-17, 19-21, 24-26, 28-29, 34-36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamazaki et al. 6025429 in view of Weaver et al. 5352289, Dickerson 4755371, Industrial Carbon and the Medalia article.

Yamazaki teaches in the entire document, especially ex. 6 and col. 11, examples of acetylene blacks having low ash and grit contents, and iodine values of 92 and 110. Col. 1 teaches polymers and col. 3 teaches the loading. This does not explicitly teach all the claimed properties, however Weaver teaches in col. 3 that acetylene blacks are known to be low in ash and S, which is expected because they are made from a source which contains little or no S or metals. Note also the DBP values recited. Dickerson teaches in column 6 the claimed 325 mesh residue for carbon black. The Industrial Carbon reference is presented as evidence that as-synthesized carbon blacks meet the 325 mesh limitation. Therefore, it appears based upon this additional evidence that the carbon black of Yamazaki renders the claims unpatentable. The particle size is unknown, but a difference should be shown.

Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki et al. 6025429 in view of Weaver et al. 5352289, Dickerson 4755371, Industrial Carbon and the Medalia article above.

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The references do not teach the claimed pipe, however forming one is an obvious expedient to create an useful artifact made of the carbon and polymer with the desired properties.

Claims 1-3, 11-21, 24, 34-36, 37-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Giet 4013759 in view of Dickerson, Weaver, Medalia article and Industrial Carbon.

Giet teaches, in the entire patent but especially in column 6, high purity carbon black which can possess the claimed area due to the correspondence of iodine and nitrogen areas. It is noted that Giet does not actually specify which area is reported, so a difference may not exist. The 74 micron residue reported is 200 mesh; so the 200 mesh residue is known to be zero. Dickerson, Weaver, Medalia and Industrial Carbon are relied upon as above. Concerning claims 34-36, no difference is seen due to the similarity of the other properties.

Claims 1-21, 24, 26-30, 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giet in view of Dickerson, Weaver, Medalia article and Industrial Carbon, and taken with Von Konynenburg.

Giet not does show a polymer material, but teaches the advantages thereof in col. 1. Using the clamed polymers is an obvious expedient to provide an 'electro-conductive rubber' composition. The amount of carbon is deemed an obvious expedient of optimization of properties; the wide range of ratios include what appear to be conventional ratios- see Von Konynenburg col. 8 and 15. Note also In re Boesch 205 USPQ 215. Claim 30 appears to encompass normal shapes of extruded polymer.

Applicant's arguments filed 6/30/08 have been fully considered but they are not persuasive. Previous arguments apply. Arguments to withdrawn rejections are moot or persuasive, in view of the amendment. The arguments concerning the Sant references rely upon semantics in the specification. No patentable difference is seen between 'carbon black' and 'carbon black

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products' since carbon blacks are decomposition products. Given that the references belong to the applicant, it is not seen why an analysis could not be undertaken. Concerning the ODP over '790, it is argued that the specification thereof cannot be relied upon. However, this is not true, because inherent properties are being relied upon. The argument concerning '386 is similar. Note that that patent also refers to Sant '250 as the basis for its synthesis, just like the present specification does. This is evidence that the carbon blacks do not patentably differ. Since '790 and '386 are both owned by the applicant, it is not seen why an analysis could not be offered to demonstrate the properties of these carbons. Concerning Yamazaki, the ash (and sulfur) limitation does not distinguish, since the reference does not use oils (which are known to contain ash and S compounds) but rather gases. What Medalia teaches about normal ash contents of oil blacks is irrelevant. To amplify this point, it is noted that gas supplied to ordinary homes is so pure that the gas company deliberately adds mercaptan (S compound) in trace amounts to permit it to be detected by smell.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.

/Stuart Hendrickson/  
Primary examiner Art Unit 1793